

BS00186
Serial No. 09/921,272 Examiner LY Art Unit 2686
Response to December 29, 2005 Office Action

REMARKS

In response to the Office Action dated December 29, 2005, the Assignee respectfully requests entry of the above claim amendment and the following remarks. The Assignee again respectfully submits that the pending claims are ready for a Notice of Allowance.

Claims 2-8 and 49 are pending in this application. The United States Patent and Trademark Office (the "Office") rejects claims 2, 8, and 49 under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent 6,058,311 to Tsukagoshi in view of U.S. Patent 6,101,394 to Illidge and further in view of U.S. Patent 6,393,298 to Fulton *et al.* and further in view of U.S. Patent 5,521,961 to Fletcher *et al.* and further in view of U.S. Patent 6,587,446 to Sarkar *et al.* Claim 3 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Tsukagoshi* in view of *Illidge* and further in view of *Fulton* and further in view of *Fletcher* and further in view of *Sarkar* and further in view of U.S. Patent 5,465,388 to Zicker. Claim 4 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Tsukagoshi* in view of *Illidge* and further in view of *Fulton* and further in view of *Fletcher* and further in view of *Sarkar* and further in view of *Zicker* and further in view of U.S. Patent 4,856,083 to Makino. Claims 5-7 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Tsukagoshi* in view of *Illidge* and further in view of *Fulton* and further in view of *Fletcher* and further in view of *Sarkar* and further in view of U.S. Patent 6,741,872 to Pinault.

These rejections are respectfully traversed for at least the following reasons.

Discussion with Examiner Ly

Examiner Ly discussed this response. On Monday, March 20, 2006 Examiner Ly and Scott Zimmerman discussed this response. Scott Zimmerman explained how *Tsukagoshi* receives an updated temporary identifier with each registration response. Independent claims 8 and 49, however, transmit the same GAN with each registration request. Examiner Ly agreed and said he would speak with the supervisory examiner.

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Tsukagoshi "Teaches Away" from the Claims

Tsukagoshi "teaches away" from the pending claims. "A reference that 'teaches away' from the claimed invention is a significant factor" when determining obviousness. See M.P.E.P. at § 2145 (X)(D)(1). A reference must be considered as a whole, including portions that lead away from the claimed invention. See *id.* at § 2141.02; see also *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. (BNA) 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). "It is improper to combine references where the references teach away from their combination." M.P.E.P. at § 2145 (X)(D)(2). If the proposed combination changes the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to support a *prima facie* case. See M.P.E.P. at § 2143.01.

The Office's proposed combinations all require an impermissible change to *Tsukagoshi*'s principle of operation. The Office attempts to combine *Tsukagoshi* with *Illidge*, *Fulton*, *Fletcher*, *Sarkar*, *Zicker*, *Makino*, and/or *Pinault*. As the following paragraphs will explain, however, all the proposed combinations update a temporary identifier with each location registration and with each call set-up. Independent claim 8, however, "register[s] with a service provider by randomly selecting a GAN and transmitting the GAN as well as the HSN to the service provider" and "receiv[es] at the wireless device a registration response comprising the randomly-selected generic access number (GAN) and multiple identifications of multiple radio channels" (emphasis added). All the proposed combinations involving *Tsukagoshi*, in contradistinction, receive an updated temporary identifier with each registration response. *Tsukagoshi*, in other words, does not receive the same "randomly-selected generic access number (GAN)" that was sent with the registration request. The Office's proposed combinations, then, all require impermissible changes to *Tsukagoshi*'s principle of operation.

Tsukagoshi explains the principle of operation. "A new temporary identifier is assigned to a mobile terminal each time a predetermined condition is satisfied, for example, when the mobile terminal enters the network of another common carrier or another location registration area, or when a calling request is made by the mobile terminal." U.S.

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Patent 6,058,311 to Tsukagoshi (May 2, 200) at column 3, lines 32-37 (emphasis added). "A temporary identifier is updated by triggers 401-403, that is, **when moving from the home network to the network of the common carrier B, when moving from the network of the common carrier B to the network of the common carrier C, and when moving from the network of the common carrier C to the home network, respectively.**" *Id.* at column 3, lines 62-67 (emphasis added). "Referring to FIG. 3, there are shown further triggers 404-406 which cause the change of temporary identifier in the service area of a home memory station." *Id.* at column 4, lines 1-3. "The temporary identifier is changed when the mobile terminal MT moves from a location registration area RA₁ to an adjacent location registration area RA₂ (trigger 404)." *Id.* at column 4, lines 3-6 (emphasis added). "The temporary identifier is also changed when the mobile terminal MT requests the location registration at power-on, or when a calling request or a response to incoming call is made by the mobile terminal MT (trigger 405)." U.S. Patent 6,058,311 to Tsukagoshi (May 2, 200) at column 4, lines 6-10 (emphasis added). "Further, when the time-out period of the location registration has elapsed, the nearby base station requests the location registration of the mobile terminal MT and thereby the temporary identifier is updated (trigger 406)." *Id.* at column 4, lines 10-14 (emphasis added). "In other words, location registration or call setup causes a temporary identifier to be updated." *Id.* at column 4, lines 15-16 (emphasis added).

Tsukagoshi continues explaining the principle of operation. The temporary identifier is assigned upon initial registration. *See id.* at column 4, lines 20-42. When the mobile terminal attempts to register with another carrier (e.g., "common carrier B"), the mobile terminal transmits an authentication/location registration request using the temporary identifier ID_{TEMP1}. U.S. Patent 6,058,311 to Tsukagoshi (May 2, 200) at column 4, lines 50-55. Because the temporary identifier ID_{TEMP1} is not registered, common carrier B transmits the temporary identifier ID_{TEMP1} to the home network. *See id.* at column 4, lines 56-63. The home network authenticates the mobile terminal and then transmits an authentication response to common carrier B. *See id.* at column 5, lines 1-6. The common carrier B transmits the location registration request to the home network. *See id.* at column 5, lines 7-10. "The home [network] performs the location registration of the mobile terminal MT and then releases the data link of the temporary identifier ID_{TEMP1}." U.S. Patent 6,058,311 to Tsukagoshi (May 2, 200) at

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column 5, lines 10-12 (emphasis added). After that, the response indicating the completion of location registration is transmitted back to the common carrier B. *See id.* at column 5, lines 13-15. "When receiving the completion notification of location registration, the [common carrier B] assigns a new temporary identifier **ID_{TEMP2}** to the mobile terminal MT and links the data of the mobile terminal MT with the new temporary identifier **ID_{TEMP2}** in the database." *See id.* at column 5, lines 16-20 (emphasis added). "After that, the common carrier B transmits the completion notification of location registration and the temporary identifier **ID_{TEMP2}** to the mobile terminal MT." *See id.* at column 5, lines 21-24 (emphasis added). The assigned temporary identifier **ID_{TEMP2}** is stored in the mobile terminal MT and used to access the common carrier B. *See id.* at column 5, lines 24-27.

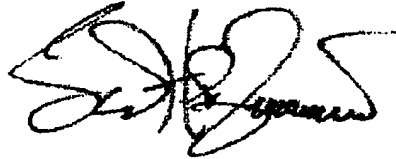
The Office should now realize that *Tsukagoshi* "teaches away" from the pending claims. The proposed combinations of *Tsukagoshi* with *Illidge*, *Fulton*, *Fletcher*, *Sarkar*, *Zicker*, *Makino*, and/or *Pinault* all update a temporary identifier with each location registration and with each call set-up. That is, all these proposed combinations receive an updated temporary identifier with each registration response. The proposed combinations cannot "[register] with a service provider by randomly selecting a GAN and [transmit] the GAN as well as the HSN to the service provider" and "receiv[e] at the wireless device a registration response comprising the randomly-selected generic access number (GAN) and multiple identifications of multiple radio channels." The patent to *Tsukagoshi* would require impermissible changes to its principle of operation in order to support a *prima facie* case. The patent case law prohibits changing a principle of operation to support a *prima facie* case. Because such changes are not permissible, *Tsukagoshi* cannot support a *prima facie* case. The *prima facie* cases for obviousness must fail, so Examiner Ly is respectfully requested to remove the § 103 (a) rejections.

For at least the foregoing reasons, independent claims 8 and 49 are considered allowable. Claims 2-7 depend from claim 8 and are considered allowable for at least the following reasons.

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If any questions arise, the Office is requested to contact the undersigned at (919) 387-6907 or scott@wzpatents.com.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Scott P. Zimmerman', with a stylized flourish at the end.

Scott P. Zimmerman
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